



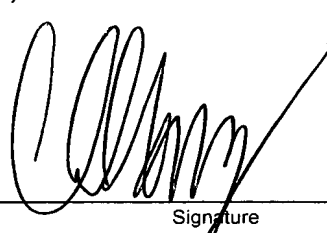
Doc Code: AP.PRE.REV

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 60258-275671	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number 09/744,750	Filed January 29, 2001
		First Named Inventor JUKKA SUONVIERI	
		Art Unit 2616	Examiner MATTIS, Jason E.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 41,844</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p> _____ Signature Christine H. McCarthy _____ Typed or printed name 703.770.7743 _____ Telephone number September 18, 2006 _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Attorney Docket: 060258-0275671
Client Reference: 2980260US/HM/HE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
JUKKA SUONVIERI

Confirmation Number: 3482

Application No.: 09/744,750

Group Art Unit: 2616

Filed: January 24, 2001

Examiner: MATTIS, Jason E.

Title: CONTROLLING PERIPHERAL DEVICE IN COMMUNICATION SYSTEM

ATTACHMENT SHEETS TO PRE-APPEAL BRIEF CONFERENCE REQUEST

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that a panel of examiners formally review the legal and factual basis of the rejection in the above-identified application prior to the filing of an appeal brief.

The Final Rejection rejected claims 1-9, 11 and 12 under 35 U.S.C. 103(a) as being obvious from the teachings of Rhodes (U.S. 5,909,437), Laham (U.S. 6,442,372) and Treatch (U.S. 5,989,382). Appellant asserts that the outstanding rejection (now on appeal by virtue of the concurrently filed Notice of Appeal) is clearly improper because the Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a). More specifically: (1) the cited prior art references, analyzed individually or in combination, fail to disclose, teach or suggest all the features recited in the claimed invention; and (2) the identified motivation to combine the teachings of the cited prior art references is impermissibly based on hindsight from reviewing Appellant's own specification. As a result, the rejection should be withdrawn.

In rejecting claims under 35 U.S.C. § 103(a), an Examiner bears an initial burden of presenting a *prima facie* case of obviousness. A *prima facie* case of obviousness is established only if there is a suggestion or motivation to combine reference teachings; a reasonable expectation of success; and the prior art references, when combined, teach or suggest all the claim limitations. If an Examiner fails to establish a *prima facie* case, a

rejection is improper and will be overturned. See In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). "If examination ... does not produce a *prima facie* case of unpatentability, then without more, the Applicant is entitled to the grant of the patent." In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

CITED PRIOR FAILS TO TEACH OR SUGGEST ALL CLAIMED FEATURES

Although the Final Rejection acknowledged that both Laham and Rhodes fail to disclose, teach or suggest a solution where a repeater is wirelessly controlled to change the frequency channels used by the transmitter and repeater, the Final Rejection erroneously asserted that Treatch remedies the deficiencies of Latham and Rhodes and that one of ordinary skill in the art would have looked to Treatch to provide such a repeater.

Nevertheless, Treatch fails to remedy the deficiencies of Latham and Rhodes because Treatch merely teaches a "system" 40 comprising three repeaters 43, 44 and 45. In practice this system is a unit with a common reception antenna 53, a common transmission antenna 49 and three agile repeaters 43 – 45, which are encapsulated together. Accordingly, Treatch merely teaches a single unit that includes an agile repeater that can be set to any channel in a band under remote control (see, Treatch, col. 3 lines 51-52) performed by a control computer 41 included in the unit (see, Treatch, col. 3 lines 60-62).

That single unit also includes a scanning receiver 51 that monitors activity in a propagation area to provide data to the control computer 41. The receiver 51 then provides data to the computer 41 concerning transmissions in the area (see, Treatch, col. 4 lines 2-3). Thus, this data is used by the control computer to adjust the frequency channels used by the repeaters (col. 3 line 65 to col. 4 line 8).

However, the data provided to the computer 41 by the receiver 51 does not correspond to control signals transmitted from the claimed subscriber station management system via a radio path to the claimed control means of the subscriber station in response to which control signals the control means control and supervise the operation of the radio repeater such that the frequency channels received by the radio receiver and the frequency channels used by the radio transmitter change.

In fact, Treatch actually teaches away from the claimed invention by teaching that a repeater should be able to independently adjust the frequency channels used by its equipment without any outside control. Based on such teachings, one of ordinary skill in the art would not have been motivated to alter the combined teachings of Rhodes and Laham to provide the

claimed invention, wherein a subscriber management system via a radio path transmits control signals to a subscriber station connected to a repeater such that the subscriber station changes the frequency channels used by the repeater.

Thus, the obviousness type rejection is deficient to establish a *prima facie* case of obviousness because the cited prior art references do not teach or suggest all the features recited in the rejected claims.

DEFICIENT MOTIVATION TO COMBINE REFERENCES

As explained previously on the record, one of ordinary skill in the art would not have combined the teachings of the cited prior art in the manner alleged by the Office Action without impermissibly looking to Appellant's specification for motivation.

Thus, Appellant asserts that a *prima facie* case of obvious has not been established because one of ordinary skill in the art would not have recognized which features would need to be incorporated in what way from the teachings of the references or the prior art in general without impermissibly looking to Appellant's own specification for hindsight analysis and motivation. Although Laham and Treatch both disclose radio repeaters, neither reference discloses a subscriber station which would be attached to a repeater and which, in response to control signals received via a radio path, would control the frequency channels used by the repeater. However, the Final Rejection has provided no explanation for why or how one of ordinary skill in the art would have reconfigured the teachings of Laham and Treatch to provide the claimed invention features based on the teachings of Rhodes.

Accordingly, for these reasons, the rejection of claims 1-9 and 11-12 is traversed and those claims are allowable. All rejections and objections having been addresses, Appellant asserts that the Application is in condition for immediate allowance. However, if anything further is necessary to place the application in condition for allowance, Appellant requests that the Examiner telephone Appellant's undersigned representative at the number listed below.

SUONVIERI -- 09/744,750
Attorney Docket: 060258-0275671

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP
SHAW PITTMAN LLP

By: 

Christine H. McCarthy

Reg. No.: 41,844

Tel. No.: (703) 770-7743

Fax No.: (703) 905-2500

Date: September 18, 2006
P.O. Box 10500
McLean, VA 22102
(703) 770-7900